



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,021	11/13/2001	Robert A. Weiss	UCT-0019	1427
23413	7590	09/24/2004	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			JOLLEY, KIRSTEN	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 09/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Sc

<b>Advisory Action</b>	<b>Application No.</b> 10/054,021	<b>Applicant(s)</b> WEISS ET AL.	
	<b>Examiner</b> Kirsten C Jolley	<b>Art Unit</b> 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 4.

Claim(s) rejected: 1-3 and 6-13.

Claim(s) withdrawn from consideration: 14-21.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### ADVISORY ACTION

1. The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search and they do not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. For example, proposed amended claim 1 would now be rejected over the prior art of Y. Fu, D. Palo, C. Erkey and R. Weiss "Synthesis of Conductive Polypyrrole/Polyurethane Foams via a Supercritical Fluid Proces" in view of Weiss et al. in view of Y. Fu, R. Weiss, and M. Bessette "Conductive Elastomeric Foams Prepared by In Situ Vapor Phase Polymerization of Pyrrole and Copolymerization of Pyrrole and N-Methylpyrrole" for reasons similar to those of section 16 of the Office action mailed January 2, 2004 because it is the Examiner's position that the phrase "a halogen catalyst in a vapor phase" is broad enough to read on the use of liquid iodine in a supercritical fluid solvent.
2. Applicant's arguments regarding the objection to the specification are convincing that antecedent basis for the amendment is found in claim 9 as originally filed. The objection to the specification will be withdrawn upon appeal.
3. Regarding the claim rejections under 35 USC 112, 1<sup>st</sup> paragraph for enablement, applicant argues that the present application enables use of vaporous halogens as originally filed. Applicant cites a submitted article, filed subsequent to the filing of the present application, to provided evidence of enablement. Applicant states that MPEP 2164.05 states that applicant may submit evidence of enablement after the filing date that demonstrates that the claimed invention works. This is unconvincing to the Examiner. The Examiner notes that MPEP 2164.05(a) states:

Art Unit: 1762

- "The state of the art existing at the filing date of the application is used to determine whether a particular disclosure is enabling as of the filing date. *Chiron Corp v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1325-26 (Fed. Cir. 2004)."

- "Publications dated after the filing date providing information publicly first disclosed after the filing date generally cannot be used to show what was known at the time of filing. *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402, 405-06 (CCPA 1976); *In re Budnick*, 537 F.2d 535, 538, 190 USPQ 422, 424 (CCPA 1976)."

Regarding the claim rejections under 35 USC 112, 1<sup>st</sup> paragraph for written description, applicant argues that the Board of Patent Appeals & Interferences has consistently held that the specification does not require a literal statement supporting a negative limitation. Applicant also argues that the present specification includes examples wherein polyurethane foams are impregnated with vaporous iodine, such impregnation clearly being carried out in the absence of supercritical carbon dioxide. The Examiner acknowledges that the specification does not have to contain literal support for a claim limitation. However there is nothing to suggest that supercritical carbon dioxide was necessarily excluded from the examples and general teachings of the specification. Further, the Examiner notes that it has been held that negative limitations, which did not appear in the specification as-filed, introduce new concepts and violate the description requirement of 35 U.S.C. § 112. *Ex parte Grasselli et al.*, 231 USPQ 393 (Bd Pat App & Int 1983): "It might be added that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. This clearly illustrates that such negative limitations do, in fact, introduce new concepts."

Art Unit: 1762

With regard to the claim rejections under 35 USC 102(b), it is noted that the proposed claim amendments have not been entered and therefore the rejections are maintained.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kirsten C Jolley  
Patent Examiner  
Art Unit 1762

kcj